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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 1603

HELEN WILLS STRONG and KEARNEY-NATIONAL, INC., *Petitioners*

v.

GENERAL ELECTRIC COMPANY, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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INDEX

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
(a) As to the Certiorari Policy	2
(b) On the Merits	2
Constitutional Provisions and Statutes Involved	3
Introductory Statement	3
Statement of Facts	4
1. Best Evidence Rule Ignored	4
2. Law of *Marconi Wireless Telegraph Co.* Improperly Applied	5
3. Error of Law in Equating "Gift" With Statutory Language "On Sale" of Section 102 (b)	7
4. The City of Albany Defense	10
Conclusion	11
Appendix	1a
Constitutional and Statutory Provisions	1a
Per Curiam Opinion of Court of Appeal With Opinions of District Court	2a
Judgment of the Court of Appeals	14a
Petition for Rehearing and Hearing En Banc	15a
Judgment of the District Court	16a

CITATIONS

CASES:

Amerio Contact Plate Freezers Inc. v. Belt-Ice Corp., 316 F.2d 459 (9th Cir., 1963)	9
Marconi Wireless Telegraph Co. v. United States, 320 U.S. 1 (1943)	3

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Petitioners, Helen Wills Strong and Kearney-National Inc., pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit in the above-entitled case.

OPINIONS BELOW

The *per curiam* opinion of the Court of Appeals is reported at 434 F.2d 1042 (5th Cir., 1970) and is reprinted in Appendix (p. 2a). The opinions of the District Court for the Northern District of

Georgia are reported at 305 F. Supp. 1084 and 1089 and were adopted *in toto* by the Court of Appeals. They are reprinted in the Appendix as part of the Court of Appeals decision, which added only a brief paragraph to them (p. 3a to p. 13a).

JURISDICTION

The judgment of the Court of Appeals was entered on December 8, 1970 (Appendix p. 14a). A timely Petition for Rehearing and Petition for Hearing En Banc was denied on January 21, 1971 (Appendix p. 15a). The jurisdiction of this Court is invoked pursuant to 28 U.S.C. Section 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. Sections 1332 and 1338.

QUESTIONS PRESENTED

(a) As to the Certiorari Policy

Should not this Court, after years of silence, determine

(1) Whether the "best evidence" rule is no longer viable, and

(2) Whether the giving of an invented article in incomplete form, for trial and approval only, more than one year prior to the filing of a patent application, constitutes a public use or on sale within the purview of Section 102(b) of the Patent Act of 1952.

(b) On the Merits

The patents in suit, relating to meter boxes, are U.S. Patent No. 3,123,744 owned by Petitioner Kearney-National Inc., (hereinafter referred to as the "Fisher Patent") and U.S. Patent No. 2,991,398 owned by Petitioner Helen Wills Strong, widow of the de-

ceased inventor, Carll W. Strong (hereinafter referred to as the "Strong Patent") and under which Petitioner Kearney-National Inc. is an exclusive licensee.

The questions presented on the merits are:

(1) Whether a "blown-up" photographic copy of a page of a publication indistinctly disclosing what respondent alleges to be the subject-matter of the patent in suit constitutes the "best evidence" where no excuse has been offered for failure to produce the original, admittedly in existence.

(2) Whether *Marconi Wireless Telegraph Co.* v. *United States,* 320 U.S. 1 (1943) was meant to be applied posthumously to convict a deceased inventor of fraud when he cannot defend himself and his widow does not have the information to do so.

(3) Whether there is no distinction between a gift and a sale of the subject matter of an invention under 35 U.S.C. Section 102(b) in spite of the express language of "on sale" of that section and absence of any mention of "on gift" therein.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8 of the Constitution, and Sections 101 and 102, of the Patent Act of 1952, 35 U.S.C. Sections 101 and 102. (Appendix, p. 1a to 2a).

INTRODUCTORY STATEMENT

To the best of petitioner's knowledge and belief, this Court has never affirmed its adherence to the "best evidence" rule in any civil case. It has never given the Courts of Appeals a ruling on what constitutes "public

use or on sale" within the purview of Section 102(b) of the Patent Act of 1952 (35 U.S.C.).

Analysis of prior opinions indicates this neglect has caused considerable diversity of opinion in the Courts of Appeals as to what constitutes "public use or on sale", culminating in the adherence of the Court below to a District Court decision that a gift is the same as a sale under Section 102(b).

The Chief Justice of this Court, the Honorable Warren E. Burger has voiced publicly his concern with the burdensome and crowded dockets of our Courts. This case furnishes an ideal opportunity for the Court, by granting certiorari, to contribute to the diminution of such dockets by stating authoritatively what constitutes public use or on sale in patent causes, and by reaffirming the viability of the "best evidence" rule.

In addition, this Court has made no further statement of law since *Marconi* in 1943, and thus it has been enlarged by the lower courts to cover a situation to which this Court never intended it should be applied.

STATEMENT OF FACTS

1. The "Best Evidence Rule" Ignored—Electrical South Publication

As proof of invalidity of the Strong patent, the Courts below accepted as evidence, over strenuous objections of petitioners' counsel, an indistinct high enlargement low resolution "blow-up" of an article in complete disregard of the "best evidence rule" (See IV Wigmore On Evidence, 3d, ed. Section 1178). Petitioners' counsel requested the original from which the enlargement had been made. Counsel for respondent

admitted the existence of the original but refused to produce it and made no excuse for failure of production. Petitioners' motion to strike this evidence for failure to comply with the "best evidence rule" was overruled by the District Court.

In its decision filed June 13, 1969 (p. 3a, to p. 10a), the District Court solved the problem that obviously the Electrical South publication was not the best evidence in a simple manner: it disregarded it. The Court of Appeals, after granting but 15 minutes for oral argument, wrote a one-paragraph decision, adopted the District Court's decisions, and forgot the matter. Unless this Court will apply resuscitation, the "best evidence rule" is apparently dead in the Fifth Circuit, and any photocopy, however indistinct or altered, is readily acceptable. If the alteration is fraudulent, that is just the chance a litigant in the Fifth Circuit takes.

2. The Law of Marconi Wireless Telegraph Co. Was Improperly Applied

As a final degradation resulting from the acceptance of the indistinct photograph, *supra,* the lower courts said that certain claims of the Strong patent were invalid under *Marconi Wireless Telegraph Co., supra.* Since in *Marconi* fraud was found, the lower courts were holding Carll Strong a criminal 13 years after his death. If so, the courts committed error of law in improperly applying *Marconi,* which is not apposite to the facts surrounding the Electrical South publication.

In Marconi the patentee, Fleming, had written a paper in 1890 attributing a certain invention to others. That invention was later embodied in certain claims of his patent. He received his patent in 1905 and in 1915

his assignee, Marconi, disclaimed the invention of those claims. This Court held at pp. 58 and 59 of 320 U.S.:

> "Fleming's paper of 1890 showed his own recognition that his claim of use of his patent for low frequency currents was anticipated by Edison and others. It taxes credulity to suppose, in the face of this publication, that Fleming's claim for use of the Edison tube with low frequency currents was made 'through inadventence, accident or mistake', which is prerequisite to a lawful disclaimer. No explanation or excuse is forthcoming for his claim of invention of a device which he had so often demonstrated to be old in the art, and which he had specifically and consistently attributed to Edison. Nor is any explanation offered for the delay of the patentee—the Marconi Company—in waiting ten years to disclaim the use of the device with low frequency currents and to restrict it to a use with high frequency Hertzian waves which Edison had plainly foreshadowed but not claimed."

It is believed apparent that *Marconi* was incorrectly applied. Here there was no recognition by inventor Carll Strong that another had made his invention, nor a disclaimer filed. On the contrary, the petitioners contend and still believe that Electrical South did not disclose the subject-matter of the Strong patent. As far as an explanation or excuse is concerned, Carll Strong is not able to give one. Carll Strong died December 17, 1956, long before the present action originated, and in fact, well prior to respondent's first infringement of his patent. So the lower courts have coupled an indistinct photographic copy of a page from a publication to the *Marconi* case in which the accused could have but did not come forth to explain an incongruity, to condemn a deceased inventor with a fraudulent, criminal act.

3. An Error of Law Was Committed in Equating "Gift" With the Statutory Language "on Sale" of Section 102 (b).

(a) Background

The litigation concerns the field of meter boxes, sometimes referred to here as meter sockets. When used to hold socket-type electric meters, they form an enclosure with electrical connections leading to jaws into which the meter is thrust. *The meter box is in use when it holds a meter and is attached to a house or other structure in which electricity is utilized.* The Strong patent is a basic patent in this field and some knowledge of its structure is requisite to an understanding of this appeal. The Fisher patent is an improvement patent on the Strong invention; because of the basis on which it was held invalid, no knowledge of its structure is requisite.

The Fisher patent was held invalid on summary judgment on one basis only—that the subject matter thereof had been in public use and on sale to Duke Power Company more than one year prior to the filing of the patent. As the application for the Fisher patent was filed in United States Patent Office on April 4, 1962, the critical date for establishing public use or on sale was April 4, 1961.

Petitioners have always admitted that between March 27 and 31, 1961, Sam Crowe, president of the first licensee, B & C Stamping Company, visited the Duke Power Company at Charlotte, North Carolina. Mr. Crowe left samples of meter boxes according to the Fisher patent with Duke Power without receiving compensation or the expectation of same.

What happened to the samples after Sam Crowe left them with Duke Power and more specifically in

the period of one week or 10 days between the time he left the boxes and the statutory bar date? Without doubt, there came a time when Sam Crowe's samples were tested by Duke Power to determine by trial whether they met Duke Power's standards. *From the record, we cannot tell whether that happened between March 27, 1961 and April 4, 1961, the critical date, or after the critical date.* Without doubt, the Fisher meter box was ultimately placed on Duke Power's approved list, but the record does not show when that occurred. There is nothing in the record that shows a sale of these meter boxes to Duke Power and the Courts below never held they were sold. *Nevertheless, despite the fact the sample boxes were incomplete and without meter attachments, the empty boxes were deemed by the Courts below to be in public use and on sale to Duke Power between March 27, 1961 and the critical date of April 4, 1961, equating gift and sale contrary to the statute.*

The Strong patent No. 2,991,398 issued on July 4, 1961 on an original application filed May 5, 1952, the critical date is May 5, 1951, one year prior to the filing date of the application. For present purposes, it is not necessary to point out all the advantages of the Strong structure. Carll Strong invented a *ringless, gasketless* meter box, a useful and novel improvement over the prior art, which formerly utilized a separate sealing ring, or a gasket of cork or rubber between the box cover and the base of the meter.

The facts regarding Georgia Power's possession of Strong meter boxes are almost identical to the facts surrounding Duke Power's possession of Fisher meter boxes, *supra.* In both instances the samples were given without compensation or the expectation of same.

In its Order granting Summary Judgment, the lower courts did not dispute the patent owners contention that Sam Crowe gave the sample meter boxes to Duke Power and did not sell them. That the Court had to do because there was no evidence of a sale. The Court, however, equated gift and sale, stating at (p. 12 a):

> "Plaintiffs contend that the boxes were *given* rather than *sold* to Duke Power and that a gift does not invalidate a patent under 35 U.S.C. § 102 (b). That contention is utterly without merit. An inventor may not prolong the statutory period of monopoly by any means whatever and it matters not one iota whether he seeks to do so by 'giving' the invention away instead of by selling it—the result is the same, *i.e.*, if he does so more than one year before applying for his patent he loses any right he might otherwise have had to patent the invention." [Original Emphasis]

It is respectfully submitted that the lower courts misinterpreted § 102(b) as a matter of law. That section specifies "on sale", not "on gift". This misstatement of the law casts doubt on the lower courts interpretation of § 102(b) in its entirety.

A good explanation of the rationale behind the defense of "on sale" is explained by the Court of Appeals for the Ninth Circuit in *Amerio Contact Plate Freezers, Inc.* v. *Belt-Ice Corp.*, 316 F.2d 459 (9th Cir. 1963), at page 465, as follows:

> "The purpose of the 'on sale' provision of the statute is to prevent an inventor from having the advantage of a monopoly for more than the statutory period by engaging in the competitive exploitation of his invention after it is fully developed before applying for a patent. * * *

> "Ordinarily, however, selling activity (at least activity short of actual sales) prior to the time that a fully-operative article or apparatus incorporating the invention comes into existence, is not a reliable indicium of competitive exploitation. Until at least an operative prototype has been completed and tested, the competitive effectiveness of such activity, in all probability, will be impaired by the aura of continuing developmental, experimental and testing effort. Moreover, at this stage, such activity is likely to be more for the purpose of eliciting needed changes in design and testing whether the market potential warrants continuance of the project, than to launch full-fledged commercial exploitation."

There is no evidence that petitioners engaged in any "commercial or competitive exploitation" of its meter boxes prior to the critical dates. There is no evidence that the power companies had actually used, tested, or approved the meter boxes prior to the critical dates.

4. The City of Albany Defense

Respondent attempted to establish actual sales of the Strong meter boxes to the City of Albany.

The only evidence submitted in support of this defense was two purchase orders dated prior to the critical date of May 4, 1951 bearing the indicia "WV-011". Respondent's witnesses could not identify the type of meter boxes which were the subject-matter of the purchase orders. Petitioner's witness testified that the same designation "WV-011" had been used and applied "over the years" to both ring-type and ringless type meter sockets. Resolving every doubt in favor of the patent as the law requires, there was no clear and convincing evidence of a sale to the City of Albany.

CONCLUSION

Petitioners respectfully urge the lower courts committed reversible error in failing to adhere to the "best evidence rule", in misconstruing and misapplying *Marconi Wireless Telegraph Co., supra.,* and the law of public use, on sale and anticipation of 35 U.S.C. Section 102(b).

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX

Constitutional and Statutory Provisions

1. Article I, Section 8, Clause 8, of the Constitution provides:

> The Congress shall have Power . . .
>
> * * * * * * * * * *
>
> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . .

2. Sections 101 and 102 of the Patent Code of 1952 provide (35 U.S.C. §§ 101-02):

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed

more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 29148

HELEN WILLS STRONG and
KEARNEY-NATIONAL, INC.,
Plaintiffs-Appellants,

versus

GENERAL ELECTRIC COMPANY
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Georgia

Before THORNBERRY, GOLDBERG and AINSWORTH,
Circuit Judges.

(December 8, 1970)

PER CURIAM: This is an appeal from the district court's judgments in appellants' suit for infringement of two patents. We AFFIRM the orders appealed from, and adopt and affirm the district court's cogent opinions, copies of which are attached hereto.

Filed June. 13, 1969

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

Civil Action No. 9508

Order

This is an action for injunctive relief, treble damages, costs, and attorney's fees, arising out of defendant's alleged infringement of two of plaintiffs' meter box patents, *i.e.*, (1) United States Patent No. 3,123,744, which is owned by Plaintiff Kearney-National, Inc., and (2) Patent No. 2,991,398, which is owned by Plaintiff Strong and under which Kearney-National is exclusive licensee. Since no evidence was introduced with regard to infringement of Patent No. 3,123,744 (the Fisher patent), all issues to be decided at this time are concerned with Patent No. 2,991,398 (hereinafter referred to as the Strong patent or Strong meter box).

The record shows that the Strong patent was applied for by Carll W. Strong on May 5, 1952, and was issued to his widow, Helen Wills Strong, as his successor in interest, on July 4, 1961. An exclusive license was granted by Mr. Strong to B & C Metal Stamping Co. of Atlanta in 1952 shortly after the patent application was filed, and some years later the license was transferred to Kearney-National. The record further shows that Defendant General Electric Company has produced meter boxes which, if the Strong patent is valid, appear to infringe upon that patent or at least upon certain of the claims contained therein.[1]

Defendant contends, however, that the Strong patent is invalid under 35 U.S.C. § 102(b) and § 103. Invalidity under § 102(b) is predicated upon the ground that more than

[1] In view of the conclusions reached on the question of patentability, the court finds it unnecessary to decide the infringing character of defendant's device.

one year prior to the date upon which the patent application was filed the Strong meter box allegedly (1) was in public use by persons other than the inventor; (2) was on sale within the meaning of § 102(b); and (3) was described in a printed publication—*Electrical South*—with sufficient clarity to enable one skilled in the art to produce the meter box which subsequently was claimed in the patent. Any one of these allegations, if proven, would serve to invalidate the patent. Furthermore, defendant contends that the patentee's failure to disclose the *Electrical South* publication to the patent office as part of the pertinent prior art constituted fraud upon the patent office and therefore invalidates all claims included in the patent, even if some of the claims otherwise would be valid.

Additionally, defendant alleges that even if the prohibitions of § 102(b) had not been violated the "invention" claimed by Carll Strong did not meet the "nonobvious" requirement imposed by § 103[1a] and therefore would have been unpatentable.

Patents issued by the United States Patent Office are, of course, presumed to be valid, but this presumption is a rebuttable one. A patent may be invalid for failing to meet any one of the requirements set forth in 35 U.S.C. §§ 101-103. Although § 103 was asserted as a ground of invalidity in the present case, the allegations and arguments were directed primarily toward § 102(b), which provides that an applicant has no right to patent an invention if more than one year before the date of the patent application the invention for which a patent is sought was in public use or on sale in this country or was described in a printed publication in this country or abroad.

[1a] 35 U.S.C. § 103 sets forth as one condition of patentability the requirement that the thing to be patented must be something which would not be obvious to one skilled in the art, considering the prior art exists at the time the patent is applied for.

The court finds that the invention claimed in the Strong patent was in fact in public use and on sale within the meaning of 35 U.S.C. § 102(b) for more than one year prior to the filing of an application for patent and that the patent is therefore invalid. Furthermore, the court finds that Claims 1, 2, and 3 of the patent were disclosed in the *Electrical South* publication in 1949 and that the applicant's failure to disclose that publication as part of the prior art brings the case squarely within the rationale of *Marconi Wireless Telegraph Co.* v. *United States,* 320 U.S. 1 (1943), and that the entire patent must therefore be held invalid on that ground also. In view of these findings the court does not reach the question of whether the invention claimed by Patentee Strong met the "nonobvious" requirement of 35 U.S.C. § 103, or whether any one or more individual claims met that requirement.

Public Use or On Sales. When, as in this case, a defendant in an infringement suit challenges the patent's validity on the ground that the claimed invention was in public use prior to one year before the patent was applied for, that defendant has the burden of showing by clear and convincing evidence that the invention was in fact used by one other than the inventor at some time prior to the one-year period permitted by the statute.[2] "[E]ven a single public use, or only a placing on sale, is sufficient to invalidate a patent under 35 U.S.C. § 102(b)." *Minnesota Mining & Mfg. Co.* v. *Kent Industries, Inc.,* 161 U.S.P.Q. 321 (6th Cir. 1969); *Tool Research & Engineering Corp.* v. *Honcor Corp.,* 367 F. 2d 449 (9th Cir. 1966), *cert. denied,* 387 U.S. 919, *reh. denied,* 389 U.S. 893 (1967). Once a prima facie case of such use has been made out, however, the burden of going forward with the evidence shifts to plaintiff, who then must show that the use was an experimental, restricted use; if the plaintiff fails to make such

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[2] Southern Implement Mfg. Co. v. McLemore, 350 F.2d 244 (5th Cir. 1965).

a showing the invention is deemed to have been dedicated to the public and therefore to be unpatentable.[3]

In this case the fact that Strong meter boxes were in Georgia Power Company's possession prior to the critical one-year statutory period (*i.e.*, prior to May 5, 1951) is not disputed; plaintiff's own witnesses have testified that dozens of the Strong meter boxes were delivered to Georgia Power prior to that date. Furthermore, the evidence specifically shows that the boxes were delivered so that Georgia Power could use them and, hopefully, add the Strong meter box to the company's approved equipment list. Plaintiffs contend, however, that this did not constitute public use because (1) it was not shown that Georgia Power used the boxes publicly; (2) the meter boxes were given—not sold—to Georgia Power; and (3) Georgia Power had to test the meter boxes before they could be approved by the company.

Even assuming arguendo that each of these three statements is true, plaintiffs' conclusion that they do not result in public use is clearly erroneous. That the public-use prohibition contained in § 102(b) refers to *any* unrestricted use by one other than the inventor, regardless of whether the user is a donee or a purchaser, is an elementary principle of patent law which is no longer open to question. It makes no difference whatever whether the invention was used in the "public eye" or not, or whether the user acquired it by gift or by sale.[4]

Plaintiff's own evidence shows (1) that the Strong meter boxes were delivered to Georgia Power for *use*, and (2)

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[3] FMC Corp. v. F. E. Myers & Bro. Co., 384 F.2d 4 (6th Cir. 1967), *cert. denied*, 390 U.S. 988 (1968); Atlas v. Eastern Air Lines, Inc., 311 F.2d 156 (1st Cir. 1962).

[4] Egbert v. Lippman, 104 U.S. 333 (1881); FMC Corp. v. F. E. Myers & Bro. Co., *supra* n.3; Tool Research & Engineering Corp. v. Honcor Corp., *supra;* Cloud v. Standard Packaging Corp., 376 F.2d 384 (7th Cir. 1967).

that no conditions of secrecy were imposed upon Georgia Power with regard to those boxes. Any use to which that company put the boxes was therefore an unrestricted use. Furthermore, even though Georgia Power announced that it must test the meter box before it could be put on the company's approved list, there is nothing to suggest that this testing was required in order to perfect or improve the meter box, or in order to demonstrate that it was marketable. Rather, Georgia Power's tests were purely and simply to determine whether Georgia Power liked the Strong meter box. The evidence clearly shows that B & C Metal Stamping Co. (the first exclusive licensee) considered the Strong meter box to be marketable and was in fact making great efforts to sell the boxes to Georgia Power and to others as well.

Furthermore, there was evidence tending to show that the City of Albany purchased ringless meter boxes from B & C in June, 1950, and again in February, 1951, and undisputed evidence showing that B & C never manufactured and sold ringless meter boxes other than those of the Strong patent type. The court finds that B & C did in fact sell Strong meter boxes to the City of Albany more than one year before the Strong patent application was filed and that it delivered meter boxes to Georgia Power Company to be used in whatever manner that company chose without restriction. The court holds, therefore, that either the City of Albany or the Georgia Power Company transactions would be sufficient to establish that the Strong meter boxes were on sale as well as in public use prior to May 5, 1951, and that any invention claimed in the Strong patent had entered the public domain and was unpatentable at the time the patent application was filed.

Anticipation by Publication. A creation which ordinarily would be patentable either as a new creation or as an improvement upon old art is not patentable if more than one year prior to the date of application for the patent the completed invention was described in a printed

publication in such detail that any person skilled in the art could use it without further instruction. In such cases, the invention is deemed to be in the public domain and therefore not patentable. Furthermore, an otherwise patentable claim within a patent may be lost to the inventor because of fraud in the procurement of his patent. One who is sued for infringement may challenge the validity of the patent on the ground that part of the device which has been patented by the plaintiff was actually not patentable.[5] Invalidity of any part of a patent will defeat the entire patent unless (1) the invalid portion was claimed through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, and (2) is disclaimed without unreasonable neglect or delay.[6]

In the instant case the evidence shows that in January, 1949, a meter box invented by Patentee Strong was described in the publication *Electrical South* and that it was represented as having a patent pending. The evidence clearly shows that the advantages claimed for the *Electrical South* meter box are also claimed in the patent applied for more than three years later, and that the components pictured and described in that publication correspond to those covered by Claims 1, 2, and 3 of the Strong patent. Plaintiffs contend, however, that the *Electrical South* meter box did not anticipate the Strong meter box because the *Electrical South* box required a gasket for sealing while the Strong meter box does not. The court finds that this allegation is completely unsupported by the evidence; no gasket is evident in the *Electrical South* illustration and nowhere in the article is a gasket even mentioned. On the contrary, the article specifically states

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[5] Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp., 382 U.S. 172 (1965).

[6] Marconi Wireless Telegraph Co. v. United States, *supra* at 57; Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., 165 F.Supp. 307, 314 (M.D. Ga. 1958).

that, "In this design, for which patents are now pending, the meter is sealed securely in place by the cover which rests firmly against the meter base rim." Plaintiffs would have the court assume that the *Electrical South* meter box contained a gasket merely because the description does not say "no gasket". This court cannot do.[7]

There was also evidence to show, and the court now finds as a fact, that the *Electrical South* publication was sufficiently clear to enable one reasonably skilled in the art to reproduce it and that the product so produced would have been the same meter box for which a patent was issued in 1961. The court also finds that the *Electrical South* publication was published with Mr. Strong's knowledge, if not at his request, so that his failure to include that publication as part of the prior art to be considered by the patent office invalidates all claims in the patent even if some of those claims otherwise would have been patentable.[8]

Plaintiffs contend that even if the *Electrical South* article did anticipate the Strong patent, it could not invalidate Claims 4 and 5 because those claims include "conducting fingers" which were not included in *Electrical South* and that since there is no evidence that failure to disclose prior art was intended to deceive, only those claims actually described in the publications can be held invalid.

Such an approach was rejected by the United States Supreme Court in *Marconi* and must be rejected here. Plaintiffs have suggested that the *Marconi* decision has been "overruled" by 35 U.S.C. §§ 253 and 288, which provide in essence that each claim in a patent stands alone and that some may stand even though others are invalid, but those

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[7] On the other hand, the description in *Electrical South* does not mention the conducting fingers claimed in Claim 4 of the Strong patent either, but in that case plaintiffs quite properly insist that the court cannot *assume* that conducting fingers were included in the prior publication.

[8] Marconi Wireless Telegraph Co. v. United States, *supra* n.6.

sections apply to invalid claims which are made inadvertently or by mistake and which are promptly disclaimed.[9]

The court finds that patentee in the instant case does not meet either of these requirements, and the anticipation of Claims 1-3 by the *Electrical South* publication therefore invalidates all claims in the Strong patent even if Claims 4 and 5 would otherwise have met the requirements of 35 U.S.C. §§ 101-103.

The defendant may therefore present a judgment in accordance with these findings and conclusions.

This 12th day of June, 1969.

/s/ NEWELL EDENFIELD
Newell Edenfield
United States District Judge

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[9] Actually Marconi was based on §§ 65 and 71 of the old statute—and these sections became 253 and 288 in the '52 statute. The language which states that these sections were designed to eliminate the harshness of the old law which invalidated all claims if any one was invalid refers to the sections as originally enacted (about 1870). Prior to that time *any* overclaiming invalidated a patent; these sections merely eliminated that result *if* (1) the overclaiming was due to inadvertence or mistake and (2) a prompt disclaimer was filed.

[Filed October 21, 1969]

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

No. 9508

Order

This is an action for injunctive relief, treble damages, costs, and attorneys' fees, arising out of defendant's alleged infringement of two of plaintiffs' meter box patents, *i.e.*, (1) United States Patent No. 3,123,744 (the "Fisher" patent), which is owned by plaintiff Kearney-National, Inc., and (2) Patent No. 2,991,398 (the "Strong" patent), which is owned by plaintiff Strong and under which Kearney-National is exclusive licensee.

Following a non-jury trial on the merits as to the validity of the Strong patent the court found that more than one year prior to the filing of the patent application the invention claimed therein had been (1) disclosed by publication and (2) in public use and on sale. The Strong patent was therefore held to be invalid and interlocutory judgment was entered accordingly. The case is now before the court upon defendant General Electric's motion for summary judgment with regard to the Fisher patent.

General Electric contends that the Fisher patent is invalid as a matter of law in that the invention described therein (1) was in public use and on sale more than one year before application for patent was made, (2) was described in a printed publication more than one year before the patent was applied for, and (3) did not represent a patentable improvement over prior art. The first ground is decisive and it is upon that ground that the court bases its decision, without reaching the questions presented by grounds (2) and (3).

It is undisputed that samples of the Fisher meter box were delivered to Duke Power Company for unrestricted

use in March, 1961, thirteen months before the patent application was filed on April 4, 1962. Plaintiffs contend that the boxes were *given* rather than *sold* to Duke Power and that a gift does not invalidate a patent under 35 U.S.C. § 102(b). That contention is utterly without merit. An inventor may not prolong the statutory period of monopoly by any means whatever and it matters not one iota whether he seeks to do so by "giving" the invention away instead of by selling it—the result is the same, *i.e.*, if he does so more than one year before applying for his patent he loses any right he might otherwise have had to patent the invention.[1]

Furthermore, plaintiffs admit that the samples were given to Duke Power Company for the express purpose of getting them put on Duke's approved list so that Duke would purchase boxes of that type from B & C. Plaintiffs contend that there was no price quotation at that time and that therefore the boxes were not "on sale" within the meaning of § 102(b). In support of that contention plaintiffs cite the case of *Chicopee Mfg. Corp.* v. *Columbus Fiber Mills Co.*, 165 F.Supp. 307 (M.D.Ga. 1958), as standing for the proposition that submission of samples constitutes placing on sale only if the samples are accompanied by a price quotation and only if submission of samples is the normal way of making sales in the business in question. This court does not understand that to be the law and a careful reading of *Chicopee* suggests that it does not support the proposition for which plaintiffs have cited it.

In *Chicopee* plaintiff's submission of samples of cloth to a designer in 1948 was held to constitute placing the

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[1] Egbert v. Lippman, 104 U.S. 333 (1881); FMC Corp v. F. E. Myers & Bro. Co., 284 F.2d 4 (6th Cir. 1967), *cert. denied*, 390 U.S. 988 (1968); Tool Research & Engineering Corp. v. Honcor Corp., 367 F.2d 449 (9th Cir. 1966), *cert. denied*, 387 U.S. 919, *reh. denied*, 389 U.S. 893 (1967); Cloud v. Standard Packaging Corp., 376 F.2d 384 (7th Cir. 1967).

cloth on sale,[2] even though there was no actual offer to sell, since the plaintiff "would have sold it . . . if [the designer] had indicated a willingness to buy and he would, of course, have also sold yardage goods corresponding to the sample."[3] There is no indication whatever that a price quotation was submitted to the designer along with the 1948 sample.

This court finds that Duke Power's unrestricted possession of the Fisher meter box more than one year prior to the patent application constituted a public use within the meaning of 35 U.S.C. § 102(b). The court finds further that plaintiffs submitted the Fisher boxes to Duke for the purpose of having the boxes approved—a necessary prerequisite to Duke's purchasing the boxes—and that submission of samples for this purpose constituted placing the boxes "on sale" within the meaning of § 102(b). The court therefore Holds that the Fsiher patent is invalid and defendant's motion for summary judgment is hereby GRANTED.

It Is So Ordered.

This 20 day of October, 1969.

/s/ NEWELL EDENFIELD
Newell Edenfield
United States District Judge

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[2] Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., 165 F.Supp. 307, 323 (M.D. Ga. 1958).

[3] *Id.* at 320.

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

OCTOBER TERM, 1970

No. 29148

D. C. Docket No. CA 9508

HELEN WILLS STRONG and
KEARNEY-NATIONAL, INC., *Plaintiffs-Appellants,*

versus

GENERAL ELECTRIC COMPANY, *Defendant-Appellee.*

Appeal from the United States District Court for the Northern District of Georgia

Before THORNBERRY, GOLDBERG and AINSWORTH, *Circuit Judges.*

Judgment

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Georgia, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered that plaintiffs-appellants pay to defendant-appellee, the costs on appeal to be taxed by the Clerk of this Court.

December 8, 1970

Issued As Mandate:

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

OCTOBER TERM, 1970

No. 29148

HELEN WILLS STRONG and
KEARNEY-NATIONAL, INC., *Plaintiffs-Appellants,*

versus

GENERAL ELECTRIC COMPANY, *Defendant-Appellee.*

Appeal from the United States District Court for the Northern District of Georgia

On Petition for Rehearing and Petition for Rehearing En Banc

(Opinion Dec. 8, 1970, 5 Cir., 1970, —— F.2d ——).

(January 21, 1971)

Before THORNBERRY, GOLDBERG and AINSWORTH, *Circuit Judges.*

PER CURIAM: The Petition for Rehearing is DENIED and no member of this panel nor Judge in regular active service on the Court having requested that the Court be polled on rehearing en banc, (Rule 35 Federal Rules of Appellate Procedure; Local Fifth Circuit Rule 12) the Petition for Rehearing En Banc is DENIED.

Judgment on Decision by the Court

UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF GEORGIA

Civil Action File No. 9508

JUDGMENT

HELEN WILLS STRONG; B & C METAL STAMPING COMPANY; and KEARNEY-NATIONAL, INC., *Plaintiffs*

vs.

GENERAL ELECTRIC COMPANY, *Defendant*

This action came on for consideration before the Court, Honorable Newell Edenfield, United States District Judge, presiding, and the issues having been duly considered and a decision having been duly rendered, granting defendant's motion for summary judgment,

It is Ordered and Adjudged that the plaintiffs, Helen Wills Strong; B & C Metal Stamping Company and Kearney-National, Inc., take nothing, that the action be dismissed on the merits, and that the defendant, General Electric Company, recover of the plaintiffs, Helen Wills Strong; B & C Metal Stamping Company and Kearney-National, Inc., its costs of action.

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Dated at Atlanta, Georgia, this 21st day of October, 1969.

CLAUDE L. GOZA
Clerk of Court

By: HELEN D. SMITH
Helen D. Smith
Deputy Clerk

Filed and entered in Clerk's Office
this 21st day of October, 1969.

CLAUDE L. GOZA, *Clerk*

By: HELEN D. SMITH
Helen D. Smith
Deputy Clerk